

REMARKS

Claims 1-53 and 55 are pending.

Claim 54 was previously canceled.

No claims are amended or added in this response.

Reconsideration of this reissue application is requested.

Applicants appreciate the Examiner's consideration of the remarks presented in the Request for Continued Examination and the withdrawal of previous rejections.

§ 103 Rejections

Claims 1-3, 7-9, 22-24, 31-32, 35, 38, 40-42 and 47-50 are rejected under 35 USC § 103(a) as being unpatentable over Johnson (US Patent 5,178,924) ("Johnson '924").

The present claims provide adhesive tape assemblies that requires a roll stability layer comprising ethylene vinyl acetate (EVA) which contacts a heat-activated adhesive layer when the assembly is formed into a roll. The Patent Office has acknowledged that Johnson '924 fails to describe such an assembly. To overcome this admitted deficiency, the Examiner has maintained the position that

; Johnson'924 discloses, in col. 4, lines 54-65, that the release material can be EAA or EVA. Therefore, it would have been obvious to one having ordinary skill in the art to use the teaching that EVA material containing tackifier, instead of EAA with tackifier, would provide for a stability layer because the two are functionally equivalent as the friction enhancing material and would provide for roll stability.

(Office Action of April 3, 2008, ¶ 9.)

Applicants respectfully maintain the position that the mere fact that two materials are listed as alternatives for one purpose (e.g., as a release material) does not provide a logically or legally sufficient basis for concluding that those two materials are functionally equivalent for any other purpose (e.g., as a roll stability layer or as a friction enhancing agent). (See, e.g.,

MPEP § 2144.06 (“In order to rely on equivalence as a rational supporting an obviousness rejection the equivalence must be recognized in the prior art, and cannot be based on ... the mere fact that the components at issue are functional or mechanical equivalents.” (Emphasis added, citing *In re Ruff*, 256 F.2d 590, 118 USPQ 340 (CCPA 1958)).)

Applicants further note that, although EAA and EVA are identified as release materials, only EAA is identified as a potential friction enhancing layer, and then only if the EAA is combined with a tackifier. In response to this argument, the Patent Office argued that Applicants had not shown that EVA and EAA would not function as equivalents as friction enhancing layers when combined with tackifiers. Applicants respectfully submit that this response improperly attempts to shift the burden to the Applicants to prove patentability, when in fact the Patent Office bears the burden of establishing a *prima facie* case of obviousness. Thus, if the Patent Office maintains its position that EVA and EAA are art recognized equivalents as roll stability layers when in contact with a heat activated adhesive, the Patent Office bears the burden of establishing this equivalence. As noted above, the Patent Office’s previous effort to do so by relying on their purported equivalence as release materials is legally insufficient.

Gronnevik 5,845,588

As a further response to Applicants’ remarks, the Patent Office now refers to col. 5, lines 36-44 and 54-57 of Gronnevik (US 5, 845,588) for purportedly teaching “that it is well known to use EVA as a friction layer to prevent slippage from a polyolefin surface.”

Gronnevik is directed toward the construction of a plastic pallet and is clearly not in the field of Applicants’ endeavor, i.e., roll stabilizing release liners. In addition, the cited disclosure of Gronnevik is not “reasonably pertinent to the particular problem with which the inventor was concerned;” therefore, Gronnevik is non-analogous art and can not be relied upon to establish obviousness. (See MPEP § 2141.01(a)(1), citations omitted.)

As discussed in the specification, the present inventors were concerned with the problem of roll stability, particularly rolls of double-sided tape having a heat activated adhesive on one side and a pressure sensitive adhesive on the other side. (See, e.g., col. 1, line 15 – col. 2, line 33.) In contrast, Gronnevik describes the use a “friction material added in the form of parallel, raised longitudinal sections having a height of approximately 1 mm” to prevent goods from

sliding on the surface of a plastic pallet or prevent the pallet itself from sliding on the floor. (Col. 5, lines 36-56.) Although the pallet itself may be formed of polyolefins, the construction of the goods and the floor are not specified. Also, the Patent Office has failed to provide any basis to conclude that any of these materials are constructed of a heat activated adhesive.

Applicants respectfully submit that one of ordinary skill in the art seeking a roll stability layer for use with a heat activated adhesive would not look to a reference directed at the construction of plastic pallets. Nor would one of ordinary skill in the art consider Gronnevik's use of 1 mm high sections of a friction enhancing material to prevent goods from slipping on the surface of a pallet or to prevent the pallet from slipping on the floor relevant to the unrelated problem of identifying a roll stability layer for use in contact with a heat activated adhesive. For example, although not explicit claim limitations, one of ordinary skill in the art would certainly recognize the challenges associated with identifying a roll stability layer for use with a heat activated adhesive such as blocking (see, e.g., col. 3, lines 5-10; col. 5, lines 22-42; and col. 5, line 57 – col. 6, line 19) that would not be addressed when seeking materials to prevent slippage on pallet. In addition, one of ordinary skill in the art would immediately recognize that the use of 1 mm high sections of a material is not a practical solution when seeking roll stability in a roll of tape where the tape itself is of comparable thickness. (See, e.g., col. 3, lines 36-47.)

For at least these reasons, the rejection of claims 1-3, 7-9, 22-24, 31-32, 35, 38, 40-42 and 47-50 under 35 USC § 103(a) as being unpatentable over Johnson '924 is unwarranted and should be withdrawn.

Claims 4-5, 43-44 and 55 are rejected under 35 USC § 103(a) as being unpatentable over Johnson '924 in view of Reinders (US Patent 6,037,028).

Applicants respectfully submit that the Patent Office has failed to show how Reinders overcomes the deficiencies of Johnson '924; therefore, the rejection of claims 4-5, 43-44 and 55 under 35 USC § 103(a) as being unpatentable over Johnson '924 in view of Reinders '028 is unwarranted and should be withdrawn.

Claims 6, 10-21, 25-30, 33-34, 36-37, 39, 45-46, 51, 53 and 55 are rejected under 35 USC § 103(a) as being unpatentable over Johnson '924 in view of Johnson '995 (US Patent 5,167,995).

Applicants respectfully submit that the Patent Office has failed to show how Johnson '995 overcomes the deficiencies of Johnson '924; therefore, the rejection of claims 6, 10-21, 25-30, 33-34, 36-37, 39, 45-46, 51, 53 and 55 under 35 USC § 103(a) as being unpatentable over Johnson '924 in view of Johnson '995 '028 is unwarranted and should be withdrawn.

Summary

Johnson '924 describes the use of EAA in combination with a tackifier as a friction enhancing layer. Notwithstanding the description of EVA and EAA as suitable release materials in Johnson '924 and the description of 1 mm high sections of “polyolefin-containing materials like EVA, EBA, and the like” to prevent goods from slipping on a pallet or to prevent the pallet slipping on a floor in Gronnevik, the present inventors have discovered that EVA is a useful and patentably distinct roll stability layer for use with heat activated adhesives in the construction of the claimed invention.

In view of the above, it is submitted that the application is in condition for allowance. Examination and reconsideration of the application is requested.

Again, Applicants appreciate the Examiner's thoughtful consideration of their previous remarks. If any issues remain following consideration of the additional comments presented in this response, Applicants request a telephone interview to more fully understand the Examiner's position and advance this case to reissuance.

Respectfully submitted,

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Date

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